

REMARKS

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, claims 10 and 22 are amended. These amendments to the claims constitute a bona fide attempt by Applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. It is believed that the amendments made herein place the entire application in condition for allowance and/or better form for appeal. These amendments were not made earlier because the claims as previously submitted were believed to be in condition for allowance. Applicants submit no new search is required since the added claim language is directed to concepts previously recited in the pending claims, as demonstrated by the Office Action's framing of the applied references in the § 103 claim rejections. Support for the amendments can be found throughout the specification (e.g., paragraphs 19, 26-27, 31, and 33), figures (FIGS. 1-3), and claims (e.g., claims 10 and 21-22) and thus, no new matter has been added. Claims 1-29 are pending.

Official Notice

The Office Action on page 3 in enumerated paragraph 7 discusses an Official Notice from the 8/17/2005 Office Action, which Official Notice does not appear in any objections or rejections of the present Office Action. The present Office Action does contain an Official Notice that did also appear in the 8/17/2005 Office Action in connection with the § 103 rejection of claim 3. Applicants present herein an explicit traversal of that Official Notice.

Claim Rejections - 35 U.S.C. § 101

Claims 17-21 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully, but most strenuously, traversed.

Applicants present below their review of some guidance on the patentability of their independent claim 17 and present further below additional demonstration of the propriety of independent claim 17. Applicants do not acquiesce in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility.

Applicants are noting some passages from the Interim Guidelines. The following appears on pages 1 and 2:

The principal objective of these guidelines is to assist examiners in determining, on a case-by-case basis, whether a claimed invention falls within a judicial exception to statutory subject matter (i.e., is nothing more than an abstract idea, law of nature, or natural phenomenon), or whether it is a practical application of a judicial exception to statutory subject matter. The guidelines explain that a practical application of a 35 U.S.C. § 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

The following appears on pages 55 and 57 (“Annex IV”):

(c) Electro-Magnetic Signals

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

...

...A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

These interim guidelines propose that such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101. Public comment is sought for further evaluation of this question.

The following appears in the “Request for Comments on Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Docket No. 2005-P-072, RIN 0651-AB98, Federal Register / Vol. 70, No. 243 / Tuesday, December 20, 2005 / Notices <http://www.uspto.gov/web/offices/com/sol/notices/70fr75451.pdf>) on page 75472:

(5) Annex IV to the Patent Subject Matter Eligibility Interim Guidelines explains why the USPTO considers claims to signals *per se*, whether functional descriptive material or non-functional descriptive material, to be nonstatutory subject matter. Does the USPTO analysis represent a reasonable extrapolation of relevant case law? If not, please explain why and provide support for an alternative analysis. If claims directed to a signal *per se* are determined to be statutory subject matter, what is the potential impact on internet service providers, satellites, wireless fidelity (WiFi ®), and other carriers of signals?

Besides the trepidation of the Interim Guidelines, it is instructive to note the language:

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

Claim 17 recites, *inter alia*:

A computer data signal embodied in a carrier wave and representing a sequence of instructions which, when executed by at least one processor, causes the at least one processor to:

Plainly, the limitations recited in Applicants' independent claim 17 "create a functional interrelationship with a computer". Plainly, the limitations recited in Applicants' independent claim 17 recite more than "physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*."

It is generally recognized that "anything under the sun that is made by man" may be patentable with three notable exceptions: abstract ideas, laws of nature, and natural phenomena. See MPEP §2106.IV.A. "These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable." Id. In short, a claim directed to the practical use of natural phenomenon is patentable, but the natural phenomenon itself is not.

The Office Action has not shown any naturally occurring instance of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to execute as recited in Applicants' independent claim 17.

Where natural phenomena, such as electricity and magnetism are claimed, the courts have held that a signal claim directed to a practical application is statutory regardless of its transitory nature. See MPEP §2106.IV.B.1(c) citing *O'Reilly v. Morse* 56 U.S. (15 How) 62, 114-19 and *In re Breslow*, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980). As stated in MPEP §2106.IV.B.1, in the final analysis under §101 the claimed invention, as a whole, must be evaluated for what it is. See *In re Abele* 684 F.2d 902, 907, 214 USPQ 682, 687. Applicants' independent claim 17 does not call for an abstract idea, a physical phenomenon, or a law of nature. When independent claim 17 is viewed as a whole, it is clear that Applicants recite the practical application of the computer data signal embodied in the carrier wave and representing

the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to execute as claimed.

In addition, the Office Action (page 6, enumerated paragraph 10) states: “The claims are directed to a computer data signal, which does not fall within one of the four statutory classes of invention under §101.”

Applicants’ independent claim 17 is appropriate. In this regard, it is instructive to observe the following representative issued patent claims including: a) very recently issued patent claims directed to a computer data signal, b) a recently-issued patent claim directed to a computer data signal that was amended to overcome a § 101 rejection, c) issued patent claims directed to a computer data signal with listed Primary Examiners of Barron and Morse, who are each listed in the Office Actions on the subject Application as Supervisory Patent Examiners, Technology Center 2100, and d) an issued patent claim directed to a computer data signal from Group Art Unit 2134, the Group Art Unit for examination of the subject Application.

USP 7,024,655 to Cobb April 4, 2006

11. A computer data signal embodied in an electromagnetic waveform, comprising:

a source code segment for processing features in design data to determine if ruled-based optical proximity correction or model-based optical proximity correction- should be used for a particular feature;

a source code segment for selecting a particular model from a set of models for correcting a said particular feature to be corrected with said model-based optical proximity correction system;

a source code segment for selectively correcting each feature to be corrected with said ruled-based optical proximity correction or said model-based optical proximity correction; and

a source code segment for outputting corrected design data.

USP 7,024,387 Nieboer et al. April 4, 2006

9. A computer data signal embodied in a carrier wave having a plurality of source code segments comprising:

a segment for processing data from a variable number of trader terminals for entering an order for an item in the form of an algorithm with constraints thereon that represent a willingness to transact, whom dynamically changing price is a dependent variable of the algorithm within the constraints and price of another item is an independent variable, the price as the dependent variable being continuously changeable responsive to changes in price of the independent variable, the algorithm representing a buy or sell order, and

a segment for a controlling a computer coupled to each of the trader terminals over a communications network and receiving as inputs,

a) each algorithm with its corresponding constraints and

b) an external price feed depicting prices of various items and contracts from external multiple data sources which may be used as an independent variable of the algorithm or an input to a constraint variable, the sources code further comprising,

a segment for matching or comparing, in accordance with the constraints and conditions, algorithmic buy/sell orders with algorithmic or non-algorithmic sell/buy orders through the use of the external multiple data sources, and

a segment for simultaneously executing a trade of said items in the same or diverse equity markets as a single electronically matched trade.

USP 7,024,272 Thomas et al. April 4, 2006

Prosecution History: Section 101 rejection was withdrawn when “embodied in a computer readable medium” was added to the original claim to “computer data signal” alone, so the signal was capable of causing functional change in a computer.

Group Art Unit: 2125

19. A computer data signal embodied in a computer readable medium, comprising:

code configured to cause a processor to implement a method for virtual machining and inspection of a three-dimensional virtual workpiece model representative of an actual workpiece, the method further comprising:

creating a three-dimensional tool model;

defining a tool path through the virtual workpiece model;

creating a plurality of two-dimensional slices from said three-dimensional tool model; and

passing each of said plurality of two-dimensional slices along said tool path and through the virtual workpiece model;

wherein material from the virtual workpiece model coming into contact with each of said plurality of two-dimensional slices passed therethrough is subtracted from the virtual workpiece model; and

conducting a virtual inspection of said virtual work piece model, comprising: generating an inspection line, said inspection line being used to intersect with the virtual workpiece model to define an inspection point;

wherein said inspection line is swept through a selected area of the virtual workpiece model, thereby collecting inspection data for the workpiece.

USP 7,020,394 to Zhang et al. March 28, 2006

9. A computer data signal comprising a code segment for determining an optimal path between a source node and a destination node in an optical network having plural network nodes interconnected with optical transmission links, the computer data signal including instructions to:

assign an electronic node to each network node, the electronic node representing an electronic switching fabric interconnecting optical-electrical-optical (OEO) transmitters and receivers of the network node;

assign optical channel nodes to each network node, each optical channel node representing an optical cross-connect for an optical channel available at the network node;

assign an internal link from the electronic node to each optical channel node only if an associated OEO transmitter is available for the corresponding optical channel associated with a particular one of the available wavelengths λ_1 through λ_m , and assigning an internal link to the electronic node from each optical channel node only if an associated OEO receiver is available for the corresponding optical channel associated with a particular one of the available wavelengths λ_1 through λ_m ;

assign an optical channel link between a pair of optical channel nodes of corresponding network nodes only if the corresponding optical channel is available on the associated optical transmission link;

assign costs to the internal links and the optical channel links; and

select an optimal path by applying a single-source shortest path algorithm.

USP 7,017,109 to Douvikas et al. March 21, 2006

25. A computer data signal embodied in a carrier wave, comprising computer instructions for:

- providing an electronic business card Web site to a user;
- allowing the creation of an electronic business card by the user using said Web site, said creation comprising:
 - allowing the user to enter information into a plurality of fields;
 - storing said information; and
 - sending an authentication email to the user, wherein a reply to said authentication email is required to complete said creation;
 - allowing the user to search for one or more electronic business cards;
 - allowing the user to view said electronic business cards; and
 - if said creation is completed, allowing the configuring of an email application to automatically include a hyperlink to said electronic business card Web site on outgoing emails.

USP 7,016,821 to Rameau et al. March 21, 2006

31. A computer data signal embodied in a digital data stream for industrializing a designed part, the system comprising the steps of:

- selecting a parting surface that divides the designed part into a first side and a second side, wherein the designed part comprises a functional specification;
- selecting a draft angle; and
- computing a change in the first side and the second side using the selected draft angle, wherein the functional specification is maintained and the first side and second side meet on the parting surface.

USP 7,016,783 to Hac et al. March 21, 2006

30. A computer data signal, said data signal comprising code configured to cause a controller to implement a method for collision avoidance using automated braking and steering comprising:

- determining an actual distance to an obstacle in a path of a vehicle;
- determining a relative velocity between said obstacle and said vehicle;
- determining a first distance sufficient to avoid collision by braking only;
- determining a second distance sufficient to avoid collision by combined braking and steering around said obstacle;
- applying braking if at least one of, said first distance exceeds said actual distance and said first distance is within a selected threshold of said actual distance; and
- if said actual distance exceeds said second distance and a lane change is permitted, applying steering control to affect a lane change.

USP 7,013,340 to Burd et al. March 14, 2006

13. A computer data signal embodied in a carrier wave by a computing system and encoding a computer program for executing a computer process performing server-side processing of postback input received from a client and associated with a client-side user interface element, the computer process comprising:

- examining the postback input received from the client to determine a hierarchical identifier of a target server-side control object in a server-side control hierarchy;

identifying the target server-side control object in the server-side control hierarchy based on the hierarchical identifier of the target server-side control object;

passing the postback input received from the client to the target server-side control object; and

processing the postback input received from the client and passed to the target server-side control object.

USP 7,010,571 to Quatrano et al. March 7, 2006

22. A computer data signal embodied in carrier wave encoded with computer program code for providing collaboration between a first user and a second user comprising:

program code for receiving, at a web site, a request from the first user with a browser;

program code for processing the request with information related to the first user to create a page with dynamic content;

program code for copying the page with dynamic content into a copy server without changing any locators in the page, the copy server having the page with dynamic content as a copied page;

program code for providing, to the first user, a locator for the copied page of the copy server, the locator allowing the first user to access the copied page from the copy server; and

program code for providing, to the second user, the locator for the copied page of the copy server, the locator allowing the second user to access the copied page from the copy server, the first user and the second user viewing versions of the same copied page; and

program code for synchronizing access to the copied page to block multiple users from operating on the copied page, synchronizing access including employing the locator by the first user for modifying the copied page such that the second user is blocked from modifying the copied page until the modifications performed by the first user are written to the copied page at the copy server from the modified dynamic content page.

USP 7,010,060 Ledvina et al. March 7, 2006

11. A computer data signal embodied in electromagnetic signals traveling over a computer network carrying information capable of causing a computer system in the network to practice the method of claim 9.

USP 7,006,055 Sukthankar et al. February 28, 2006

22. A computer data signal including program code for transmitting presentation data from a media source to a media presenter comprising:

program code for establishing a wireless link between the media source and the media presenter, the media source having a media sequence comprising frames;

program code for transmitting at least one frame from the media source to the media presenter;

program code for rendering a displayed image by the media presenter on a common medium based on the transmitted frame;

program code for selectively arbitrating among media sequences transmitted from each of a plurality of media sources; and

program code for selectively transmitting at least a portion of a subsequent frame in the media sequence from the media source to the media presenter when a

measurable difference in images from one frame to another frame is detected in the media sequence.

USP 6,931,544 to Kienhöfer et al. August 16, 2005

Primary Examiner: Morse; Gregory (who is also listed in the previous Office Action on the subject Application as Supervisory Patent Examiner, Technology Center 2100)
Group Art Unit: 2134 (the Group Art Unit for examination of the subject Application)

11. A computer data signal embodied in a carrier wave comprising:

a computer program for supporting a number of substantially unmodified transportable byte code applications on a substantially unmodified transportable byte code virtual machine, the transportable byte code virtual machine including a set of substantially unmodified base classes and a substantially unmodified primordial class loader, the program comprising:

a first set of instructions for generating a class loader for each of the transportable byte code applications in the number of substantially unmodified transportable byte code applications, the class loader providing a name space for each application, and a thread group for each application, the first set of instructions further associating a user with each application;

a second set of instructions for overlaying one or more substantially unmodified base classes to support the number of applications;

a third set of instructions for determining a calling application for a method; and

a fourth set of instructions for limiting access to a system resource by an application according to whether the user associated with the application has access to the system resource, wherein the application also has its own security management policies; and

a fifth set of instructions for, in response to an object of a first application requesting a resource of a shared base class:

identifying a first class loader that loaded the object;

if the object was loaded by a first class loader that was created for the application, using information in the first class loader and its associated namespace to identify properties of the first application; and

if the object was loaded by the primordial class loader, identifying a first thread group created for the first application and using information associated with the first thread group to identify the properties of the first application.

USP 6,779,114 to Chow et al. August 17, 2004

Primary Examiner: Barron; Gilberto (who is also listed in the instant Office Action on the subject Application as Supervisory Patent Examiner, Technology Center 2100)
Group Art Unit: 2132

13. A computer data signal embodied in a carrier wave, said computer data signal comprising a set of machine executable code operable to increase the tamper-resistance and obscurity of a targeted software program, said machine executable code executable to perform the steps of:

transforming said targeted software program by encoding a control flow of said targeted software program from a semantic structure related to an original source code for said targeted software program, into a control flow which does not have a corresponding semantic structure, by:

re-sorting assignments in said targeted software program without changing the semantic operation of said targeted software program;

copying multiple different segments of said targeted software program into new segments; and

adding fake-robust control transfers to said new segments, to increase the tamper-resistance of said targeted software program;

dissociating the observable operation of the transformed targeted software program from that of the original targeted software program and increasing the tamper-resistance and obscurity of said targeted software program.

USP 6,715,081 to Attwood et al. March 30, 2004

Primary Examiner: Barron; Gilberto (who is also listed in the instant Office Action on the subject Application as Supervisory Patent Examiner, Technology Center 2100)

Group Art Unit: 2132

13. A carrier wave embodying a computer data signal containing executable computer instructions for controlling a computer to search a database of security rules for a match between attributes specified in the rules and the corresponding attributes in a packet, the computer instructions comprising

a first code segment for arranging the database into a set of relatively stable static rules and one or more sets of dynamic security rules, wherein a static rule can be a placeholder for a set of dynamic rules, and wherein the rules including placeholders for dynamic sets of rules are arranged in the order of most specific attributes to least specific attributes,

a second code segment for partitioning a set of dynamic rules into groups according to attributes such that within each group there is no order dependency of the rules,

a third code segment for representing each group of dynamic rules by an order independent search mechanism,

a fifth code segment for searching the static rules of the database for the first static rule having attributes that match the corresponding attributes of the packet,

a sixth code segment for determining if the matching static rule is a placeholder for a set of dynamic rules,

a seventh code segment responsive to a determination that the matching static rule is a placeholder for a set of dynamic rules for searching the groups of dynamic rules associated with the matching static rule using the order independent search mechanism for a match with the packet attributes, and

an eighth code segment for applying security processing to the packet as specified by a matching static or dynamic rule.

USP 6,564,377 Jayasimha et al. May 13, 2003

Primary Examiner: Morse; Gregory (who is also listed in the previous Office Action on the subject Application as Supervisory Patent Examiner, Technology Center 2100)

Group Art Unit: 2122

11. A computer data signal embodied in a carrier wave readable by a computing system and encoding a computer program of instructions for executing a computer process performing the method recited in claim 1.

12. A computer data signal embodied in a carrier wave readable by a computing system and encoding a computer program of instructions for executing a computer process performing the method recited in claim 8.

18. A computer data signal embodied in a carrier wave readable by a computing system and encoding a data structure defining a self-describing software object to be read by a system registrar module to install and register the self-describing software object within a registration datastore, comprising:

a first data field containing data representing a dynamic link library;

a second data field derived from the first data field comprising a reserve word module;

a third data field derived from the second data field comprising one or more self-describing component data elements; and

a fourth data field functioning to indicate the end of the self-describing software object; wherein

the one or more self-describing component data elements are extracted by the system registrar module to generate data stored within the registration datastore; and

the one or more self-describing component data elements comprises:

a classID attribute containing a globally unique identifier for identifying the class;

a classVersion attribute containing a 64 bit version number for the class;

a SynchronizationServices attribute for indicating the synchronization behavior for the software object;

a LoadBalancingServices attribute for indicating the load balancing behavior for the software object;

a PoolableServices attribute for indicating the pooling feature behavior for the software object;

a JIT_activation attribute for indicating the just in time activation behavior for the software object;

a RoleAccessCheck attribute for indicating members of a specific role permitted access to the software object; and

a RoleReference attribute for performing programmatic checks for a specific role and applying different semantic behavior based upon the role membership of a caller to the software object.

USP 6,438,750 to Anderson August 20, 2002

Primary Examiner: Morse; Gregory (who is also listed in the previous Office Action on the subject Application as Supervisory Patent Examiner, Technology Center 2100)
Group Art Unit: 2122

21. A computer data signal comprising:

a loading time code segment to determine loading time of an operating system (OS) in a computer system, the loading time code segment having:

a first time retrieval code segment for retrieving a first time from a real-time clock by a basic input and output system (BIOS) prior to loading the OS into memory of the computer system;

a loader code segment for loading the OS into memory of the computer system, the OS containing a device driver;

a second time retrieval code segment for retrieving a second time from the real-time clock by the device driver;

a time difference retrieval code segment for computing a time difference based on the first and second times to obtain the loading time of the OS; and

a duration determination segment for determining a duration of information to be displayed by said computer system based on said time difference.

The above representative patent claims demonstrate, *inter alia*, the propriety of patent claims directed to a computer data signal. Applicants' independent claim 17 is more than an abstract idea, law of nature, or natural phenomenon. Applicants' independent claim 17 "creates a functional relationship with a computer". Applicants' independent claim 17 recites the practical application of a computer data signal embodied in the carrier wave and representing the sequence

of instructions which, when executed by the at least one processor, causes the at least one processor to execute as claimed.

Withdrawal of the § 101 rejections is therefore respectfully requested.

Specification Objection and Claim Rejection - 35 U.S.C. § 112, first paragraph

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Claim 29 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This objection and rejection are respectfully, but most strenuously, traversed.

In connection with disclosure of Applicants' claim 29, the Office Action (pages 5-6, enumerated paragraph 8) states: "Correction for the following is required: The specification does not disclose automatically accepting a verification email from the user verifying self-activation of disabled option." In addition, the Office Action (page 6, enumerated paragraph 12) states:

The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose automatically accepting a verification email from the user verifying self-activation of the disabled option.

As stated in MPEP §608.01(o) "Basis for Claim Terminology in Description":

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. **>See MPEP § 2111.01 and § 2173.05(a).<

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, Ex parte Kotler, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and §

1302.01. Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.

Applicants' claim 29 follows:

The computer readable storage medium of claim 25 wherein the set of instructions further causes the computer to automatically accept a verification email from the user verifying self-activation of the disabled option.

Applicants' paragraph 33 from the specification follows:

Upon receipt of the electronic enabler, the user can self-activate the disabled option at 410 by inputting the alphanumeric code on the scanner or the scanner workstation. The user can input the code using a scanner workstation keypad, keyboard, or touch screen. Also, the code can be downloaded to a compact disk or floppy disk that can be read by the medical device for activation of the option. In one embodiment, the actions of the user conclude upon self-activation of the option. In another embodiment, the user can provide a verification email forwarded to the company at 420 verifying self-activation of the software option. The user's actions are then complete and the process ends at 390.

Applicants' specification contains a written description of the invention of Applicants' claim 29, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. The meaning of every term used in Applicants' claim 29 is apparent from the descriptive portion of the specification with clear disclosure as to its import. The specification does disclose, *inter alia*, automatically accepting a verification email from the user verifying self-activation of disabled option.

Withdrawal of the specification objection and the § 112, first paragraph, rejection is therefore respectfully requested.

Claim Rejections - 35 U.S.C. § 112, second paragraph

Claims 1-29 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully, but most strenuously, traversed.

USER IS REMOTE

The Office Action (page 7, enumerated paragraph 14) stated: “a. Regarding claim 1, it is unclear whether the providing is done remotely or the user is remote.” Applicants’ claim 1 recites, *inter alia*, “(D) providing instructions to the user remote of the remotely located stand-alone medical imaging device”. Applicants placed the adjective “remote” immediately following the noun “user”. Applicants did not use the adverb “remotely” rather than the adjective “remote” to otherwise detail “providing”. Applicants’ claim 1 clearly recites that the user is remote.

Withdrawal of the § 112, second paragraph, rejection of Applicants’ claim 1 is therefore respectfully requested.

The Office Action (page 7, enumerated paragraph 14) stated: “c. Regarding claim 17, it is unclear whether the user or the receiving step are “remote from the centralized facility and the remote stand-alone device”. Applicants’ claim 17 recites, *inter alia*, “receive, at a centralized facility, a request to activate an option resident in memory of a remote stand-alone device from a user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device”. Applicants employed the adjective “remote” immediately following the detail “of the remote stand-alone device” modifying the noun “user”. Applicants did not use the adverb “remotely” rather than the adjective “remote” to otherwise detail “receive”. Applicants’ claim 17 clearly recites that the user is remote.

Withdrawal of the § 112, second paragraph, rejection of Applicants’ claim 17 is therefore respectfully requested.

USER OF DATA ENTRY MODULE

The Office Action (page 7, enumerated paragraph 14) stated: “b. Regarding claim 10, it is unclear how the user can input an alphanumeric code on the data entry module of the stand-alone device if the user is remote from the device.” Applicants’ claim 10 presented herewith recites, *inter alia*, “receive a request to activate the disabled option from a user remote from the device and the centralized facility; ... electronically transmit the alphanumeric code to the user,

the alphanumeric code configured to activate the disabled option upon user inputting of the alphanumeric code on the data entry module communicatively coupled with the stand-alone device by the user of the device remote from the device.” An exemplary implementation encompassed by Applicants’ claim language is disclosed in Applicants’ paragraphs 19, 27, and 33 from the specification:

Hospital 14 further includes a plurality of user workstations 15 and telephone stations 17 remotely located from the stand-alone medical imaging devices 12 to, among other tasks, facilitate user activation of a non-enabled software option of a stand-alone medical imaging device 12. Computer workstations 15 and telephone systems 17 allow a user to communicate with a centralized facility 16 remote from the treatment facility 14. As will be discussed, this communication between the user and the centralized facility 16 via computer workstations 15 or telephone systems 17 enable the user to request access to a non-enabled option resident in memory of a stand-alone medical imaging device 12. Each computer workstation 15 includes an internal modem to connect the workstation 15 to a communications link, such as the Internet 18, through link 19 to communicate with the centralized facility 16. Alternatively, computer workstation 15 may be directly connected to the centralized facility 16 via link 21 which can include a dedicated line or an Internet link. As will be discussed shortly, the user may access a graphical user interface via links 19 or 21 to transmit a request to self-activate a disabled option of a stand-alone medical imaging device 12. Alternatively, the user may transmit such a request through telephone system 17. In this embodiment, the user may utilize a telephone system 17 within the medical treatment facility 14 and a telephone connection 23 through a conventional telephone network 25 to transmit a telephonic activation request to the centralized facility 16. In one embodiment, the user may interactively input identification data to request activation of the non-enabled software option or, alternatively, speak directly to a customer service representative who communicates directly with the user to facilitate user activation of the non-enabled software option.

...
If the user considers the terms of use unacceptable and therefore declines to accept the contract 120, 180, the process ends 190 without the user being unable to self-activate the disabled option. On the other hand, if the contract terms are acceptable and the user provides an electronic indication of acceptance 200, i.e., electronic signature, then an activation key is generated at 210. In one embodiment, the activation key is an encrypted alphanumeric code that when input to the medical imaging device via a data entry module, such as a keypad, a keyboard, or a touch-tone screen, will activate the described option in accordance with the term of use agreed upon by the user.

...
Upon receipt of the electronic enabler, the user can self-activate the disabled option at 410 by inputting the alphanumeric code on the scanner or the scanner workstation. The user can input the code using a scanner workstation keypad, keyboard, or touch screen. Also, the code can be downloaded to a compact disk or floppy disk that can be read by the medical device for activation of the option. In one embodiment, the actions of the user conclude upon self-

activation of the option. In another embodiment, the user can provide a verification email forwarded to the company at 420 verifying self-activation of the software option. The user's actions are then complete and the process ends at 390.

In an example, the user workstations 15 and telephone stations 17 are remotely located from the stand-alone medical imaging devices 12. For example, a stand-alone device 12 comprises a scanner and a workstation 15 comprises a scanner workstation. The user does use the workstation 15 to communicate with the stand-alone device 12. The user at the workstation 15 is remotely located from the stand-alone device 12. Among other tasks, the workstations 15 and telephone stations 17 facilitate user activation of a non-enabled software option of the stand-alone device 12. This communication between the user and the centralized facility 16 via computer workstations 15 or telephone systems 17 enables the user to request access to a non-enabled option resident in memory of a stand-alone device 12. The user may use the workstation 15 to access a graphical user interface via links 19 or 21 to transmit a request to self-activate a disabled option of the stand-alone device 12. The user can input the alphanumeric code on the scanner workstation 15 via a data entry module, such as a keypad, a keyboard, or a touch-tone screen.

Applicants' claim 10 clearly recites a request to activate the disabled option is received from a user remote from the device and the centralized facility; and the alphanumeric code is electronically transmitted to the user, the alphanumeric code configured to activate the disabled option upon user inputting of the alphanumeric code on the data entry module communicatively coupled with the stand-alone device by the user of the device remote from the device.

Withdrawal of the § 112, second paragraph, rejection of Applicants' claim 10 is therefore respectfully requested.

The Office Action (page 7, enumerated paragraph 14) stated: "d. Regarding claim 22, it is unclear how the user can input an alphanumeric code on the data entry module of the stand-alone device if the user is remote from the device." Applicants' claim 22 presented herewith recites, *inter alia*, "receive a number of user inputs from a user of the medical imaging device remote from the medical imaging device; generate an alphanumeric code configured to activate the disabled option upon user inputting of the alphanumeric code on a data entry module communicatively coupled with the medical imaging device by the user of the medical imaging device remote from the medical imaging device."

An exemplary implementation encompassed by Applicants' claim language is disclosed in Applicants' paragraphs 19, 27, and 33 reproduced above and paragraphs 26 and 31 reproduced below, from the specification.

Referring to Fig. 2, the system-side process is initiated at 100, a GUI is displayed at 110 that is configured to facilitate a user request to self-enable a disabled option resident on the device. An option identifier is detected and electronically received at the centralized facility 120. The centralized facility then receives at 130 an indication that the user desires to activate the disabled option, such as, a "Try Now" command. After receiving the "Try Now" command, a computer at the centralized facility causes a prompt to be displayed on the GUI to the user requesting that the user input a number of identifiers, such as a system ID, a host ID, a facility ID, etc. The system receives the number of identifier inputs at 140. Based on the received inputs 120 and 140, a limited use contract is generated at 150. The contract includes terms specific to the user and the system and establishes the terms of the license granting the user access to the disabled option. The contract is then displayed on the GUI at 160 so that the user can "scroll" through the terms. The user is then prompted to accept or decline the terms at 170.

...

Upon accessing the website at 320, the user navigates the website at 330 to locate the appropriate window or user interface for making a request to self-activate the option and gain access for a trial period. Once the appropriate window is located 330, the user inputs at 340 a series of parameters that identify the user, the option, the system, the host, etc. The inputs enable the centralized facility to generate terms of a licensing contract and configure the electronic enabler specific to the user inputs received.

In an example, a stand-alone device 12 comprises a scanner and a workstation 15 comprises a scanner workstation. The user does use the workstation 15 to communicate with the stand-alone device 12. The user at the workstation 15 is remotely located from the stand-alone device 12. Among other tasks, the workstations 15 and telephone stations 17 facilitate user activation of a non-enabled software option of the stand-alone device 12. This communication between the user and the centralized facility 16 via computer workstations 15 or telephone systems 17 enables the user to request access to a non-enabled option resident in memory of a stand-alone device 12. The user may use the workstation 15 to access a graphical user interface via links 19 or 21 to transmit a request to self-activate a disabled option of the stand-alone device 12. The user can input the alphanumeric code on the scanner workstation 15 via a data entry module, such as a keypad, a keyboard, or a touch-tone screen. The user can provide the system a number of identifier inputs and/or a series of parameters.

Applicants' claim 22 clearly recites receipt of a number of user inputs from a user of the medical imaging device remote from the medical imaging device; and generation of an

alphanumeric code configured to activate the disabled option upon user inputting of the alphanumeric code on a data entry module communicatively coupled with the medical imaging device by the user of the medical imaging device remote from the medical imaging device.

Withdrawal of the § 112, second paragraph, rejection of Applicants' claim 22 is therefore respectfully requested.

REMOTE USER OF STAND-ALONE DEVICE

The Office Action (page 7, enumerated paragraph 14) stated: "e. Regarding claims 1, 10, 17 & 22, it is unclear how the "user" of the medical device is defined; the user is usually defined as the person using the device, however, in this situation, the user is remote from the device and not using it. Applicants' exemplary discussion above under the exemplary headings "USER IS REMOTE" and "USER OF DATA ENTRY MODULE" demonstrates the clarity of the recitation of the user in Applicants' claims.

Withdrawal of the § 112, second paragraph, rejection of Applicants' claims 1, 10, 17, and 22 is therefore respectfully requested.

Claim Rejections - 35 U.S.C. § 103:

Claims 10-12, 17-19, 22-24, and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz et al. (USP 6,672,505) and Whigham (USP 6,584,309). Claims 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz et al. and Whigham, as applied to claim 17 above, in further view of Fenstemaker et al. (USP 6,490,684). Claims 1-5, 7-12, 16-18, and 20-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rive (USP 6,301,666), Whigham and Fenstemaker. Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rive, Whigham, and Fenstemaker, as applied to claim 12 above, and further in view of Mccown et al. (US Pub. 2002/0124168). Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rive, Whigham and Fenstemaker, as applied to claim 10 above, and further in view of Steinmetz et al. Claims 6 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rive, Whigham, and Fenstemaker, as applied to claims 1 and 10 above, in view of Castagna "Something for Nothing – Phone for free, save on books, or build a home page on the house. The Web offers an abundance of free stuff-but watch out for strings." Claim 25 is rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz et al. and Whigham, as applied to claim 24 above, in view of Castagna and Dutta (US

Pub. 2002/0078177). Claim 27-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rive, Whigham and Fenstemaker, as applied to claim 1 above, in view of Rose (USP 5,708,709). Claim 29 is rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz et al., Whigham, Castagna, and Dutta, as applied to claim 25 above, in view of Takae et al. (USP 6,795,703). These rejections are respectfully, but most strenuously, traversed.

Applicants respectfully submit that the Office Action's citations to the applied references, with or without modification or combination, assuming, *arguendo*, that the modification or combination of the Office Action's citations to the applied references is proper, do not teach or suggest one or more elements of the claimed invention, as further discussed below.

For explanatory purposes, applicants discuss herein one or more differences between the Office Action's citations to the applied references and the claimed invention with reference to one or more parts of the applied references. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the Office Action's citations to the applied references correspond to the claimed invention.

INDEPENDENT CLAIM 17 DISCUSSED WITH ALL APPLIED ART

Now is discussed the patentability of independent claim 17 presented herewith relative to the references applied to all the original claims. It is instructive to review the limitations of claim 17 discussed herein in connection with the applied references to review the patentability of independent claims 1, 10, and 22.

Applicants respectfully submit that the Office Action's citations to the applied references do not teach or suggest one or more elements of the claimed invention. A careful reading of the Office Action's citations to the applied references fails to teach or suggest, for example, the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

Steinmetz discloses (column 9, lines 19-53) configuration of ATMs:

In this described exemplary embodiment a servicer may manually input an authorization key or configuration certificate by typing information into a keypad of the ATM or otherwise providing such data through an input device on the ATM. Alternatively, the servicer may input an authorization key or a configuration certificate by reading the authorization key or configuration certificate with a portable medium reader such as a card reader, a floppy disk

reader, a CD-ROM reader, or a scanner that is in operative connection with the ATM.

FIG. 3 shows a schematic view of an exemplary system 60 for authorizing the configuration of ATMs using an authorization key. Here the licensing authority 62 operates an authorization key generation[] application 64. The key generation application 64 includes an authorization algorithm 66 that is operative to produce a first authorization key responsive to[] information associated with an individual ATM 70. In the exemplary embodiment the first authorization key 72 is required to be input into a configuration software program 74 to enable the configuration software to configure the ATM 70. The exemplary configuration software 74 includes an authorization algorithm 76 that corresponds to the authorization algorithm 66 of the key generation application 64.

The authorization algorithm 76 is operative to produce a second authorization key responsive to information associated with the ATM 70. The configuration software 74 is operative to validate the input first authorization key by comparing it to the generated second authorization key. If the keys match, the configuration software 74 enables the configuration of the ATM 70 to proceed. If the keys do not match, the configuration of the ATM 70 is not allowed to proceed.

The servicer configuration of the ATM fails to disclose, *inter alia*, the activation of an option resident in memory of the ATM already in use as a remote stand-alone ATM for a remote user of the remote stand-alone ATM. Simply missing from the Office Action's citation to Steinmetz is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17. This point is even conceded by the Office Action (page 8, enumerated paragraph 16): "Steinmetz lacks the user being remote from the centralized facility and the remote stand-alone device."

So, the Office Action's citation to Steinmetz fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

The shortcomings of the Office Action's citation to Steinmetz relative to certain elements of the claimed invention have been discussed above. The Office Action proposes a combination of the citation to Steinmetz with a citation to Whigham. However, the Office Action's citation to Whigham does not overcome the deficiency of the Office Action's citation to Steinmetz. Applicants respectfully submit that the proposed combination of the Office Action's citation to Steinmetz with the Office Action's citation to Whigham fails to provide the required approach,

assuming, *arguendo*, that the combination of the Office Action's citation to Steinmetz with the Office Action's citation to Whigham is proper.

Whigham discloses the consumer 102 purchasing the product 104 from the vending machine 106 (column 3, line 52, to column 4, line 64, and column 5, line 38, to column 6, line 33):

Turning to FIG. 1, there is shown the system 100 of the present invention. System 100 is configured to allow a consumer 102 to purchase a product 104 from a vending machine 106. The product 104 is offered for sale through the vending machine 106 by product provider 108. For the purposes of this invention, the term "product" means both products and services that may be offered through a vending machine.

The system 100 comprises vending machine 106 having a local receiver 110, a cellular telephone 114 associated with the consumer 102 and having a local transmitter 116 and a network transmitter/receiver 118, and a computer (server) 120. Unless otherwise indicated the term "cellular telephone" shall include a PDA, or other personal communication device. The consumer's cellular telephone 114 is connected to the vending machine 106 via the cellular telephone's local transmitter 116, local communication link 112, and the vending machine's local receiver 110. The consumer's cellular telephone 114 is also connected to the server 120 via the cellular telephone's network transmitter/receiver 118 and telephone network 122. The telephone network 122 is a conventional cellular telephone system which allows the consumer 102 to use his or her cellular telephone 114 to establish a dial up connection with server 120.

The server 120 performs three functions. First, the server 120 receives the consumer's call requesting a particular product 104 and from the call identifies a request for the product 104 in the vending machine 106. Second, upon identifying the request for the product 104, the server 120 creates a transaction record 124. Third, in response to the request for the product 104 in the vending machine 106, the server 120 generates a vend code 126 which authorizes the vending machine 106 to dispense the requested product 104 to the consumer 102.

The server 120 may identify the request for the product 104 in several ways. In one embodiment of the invention, each product 104 has a unique dial up number for requesting the product. The server 120 captures the dialed digits and recognizes the request for the product 104 based solely on the number called to establish the connection from the cellular telephone 114 to the server 120. In another embodiment, the server may issue a query to the consumer 102 once the connection between the cellular telephone 114 and the server 120 has been established. In response to the query, the consumer 102 can identify the desired product 104 by either dialing additional digits or by a verbal response which is decoded by voice recognition software on the server 120.

The transaction record 124 created by the server 120 in response to the request for the product 104 includes an inventory record 128 and a billing record 130. The inventory record 128, identifying the product 104 and the vending machine 106, is transmitted to the product provider 108 so that the product provider 108 can restock the vending machine 106 in the conventional fashion as

indicated by line 132. The billing record 130 identifies the consumer 102 based on the consumer's association with the cellular telephone 114. The billing record 130 also includes price information and may include other information about the transaction such as time, date, and location of the vending machine 106. The billing record 130 is sent to a billing agency 134. The billing agency 134 may be the telephone company which provides the consumer 102 a bill for cellular telephone service on a regular basis. Alternatively, the billing agency 134 may be a credit card company, financial institution that has issued a debit card, or the product provider 108. Whatever billing agency 134 is authorized, the billing agency 134 bills the consumer 102 for the product 104 and collects the payment for the benefit of the product provider 108.

After the server 120 has generated the vend code 126 in response to the request received for the product 104, the vend code 126 is communicated to the consumer 102 via the telephone network 122 and the consumer's cellular telephone 114. The vend code 126 is in turn transmitted to the vending machine 106 via the local transmitter 116, the local link 112, and the local receiver 112 thereby authorizing the vending machine 106 to dispense the product 104.

...

Regardless of the form of the vend code 126 or the local link 112, the vending machine 126 is programmed to dispense the product 104 upon receiving the proper vend code 126. A unique vend code may be created and transmitted to the vending machine 106 for each product 104 available for vending machine 106. In a system having multiple vending machines, the vend code may be unique for each vending machine within the system. It should also be noted that in accordance with the system of the present invention, there is no dedicated communication link required between the vending machine 102 and the server 120 that authorizes the vending machine 106 to dispense the requested product 104.

Turning to FIG. 2, there is shown a method 200 which allows the consumer 102 to purchase the product 104 from the vending machine 106 by using his or her cellular telephone 114. The method 200 begins at step 202 and proceeds to step 203. At step 203, the consumer 102 approaches the vending machine 106 that has the product 104 that the consumer 102 wishes to purchase. From information displayed on or adjacent the vending machine 106, the consumer 102 is able to ascertain the identity of the product 104 that he or she desires. In addition, instructions for using the consumer's cellular telephone 114 to request and pay for the product 104 are displayed on or adjacent the vending machine 106. Such instructions include a telephone number to call to request the product 104 and perhaps an alpha-numeric identifier for the product 104.

From step 203 the method proceeds to step 204. At step 204, the consumer 102 in response to the instructions at the vending machine 106 dials his or her cellular telephone 114 to make a telephone connection between the cellular telephone 114 and the server 120 and via telephone network 122. At step 206, the server 120 answers the call, and a connection between cellular telephone 114 and server 120 is established via telephone network 122.

At step 208, the consumer 102 requests the product 104, and the server 120 identifies the product 104 requested by the consumer 102. A request at step 208 may be accomplished by several methods. First, each product in the vending machine 106 may have a unique dial up telephone number. Therefore, by dialing

the designated telephone number for the requested product and by establishing the connection to the server 120, the server 120 is able to identify the requested product 104 based on capturing the number dialed to make the telephone connection.

Second, a single dial up number may be used for requesting all of the products 104 for the vending machine 106. In that case, once the connection to the server 120 has been made at step 206, the server 120, at step 208, may query the consumer 102 for additional information in order to identify the particular product 104 that is requested. Such additional information may include dialing of additional digits on the cellular telephone 114 or may employ voice recognition software so that the server 120 can recognize and process a voice request from the consumer 102.

Once the server 120 has received the information from the consumer 102 from which the server 120 can identify the requested product 104, the method moves to steps 210 and 212 in which the transaction record 124 is created (step 210) and the vend code 126 is generated step 212). Steps 210 and 212 may occur sequentially as shown in FIG. 2, in the reverse order from that shown in FIG. 2 or simultaneously.

The transaction record 124 created by the server 120 in response to the request for the product 104 and that includes the inventory record 128 and the billing record 130, fails to disclose, *inter alia*, user request to self-enable a disabled option resident on the device. Simply missing from the Office Action's citation to Whigham is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

So, the Office Action's citation to Whigham fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

The shortcomings of the Office Action's citation to Steinmetz and Whigham relative to certain elements of the claimed invention have been discussed above. The Office Action proposes a combination of the citations to Steinmetz and Whigham with a citation to Fenstemaker. However, the Office Action's citation to Fenstemaker does not overcome the deficiency of the Office Action's citations to Steinmetz and Whigham. Applicants respectfully submit that the proposed combination of the Office Action's citations to Steinmetz and Whigham with the Office Action's citation to Fenstemaker fails to provide the required approach, assuming, *arguendo*, that the combination of the Office Action's citations to Steinmetz and Whigham with the Office Action's citation to Fenstemaker is proper.

Fenstemaker discloses (column 3, lines 26-51) a remote ultrasound vendor 410 transmitting a key to the ultrasound device 100:

As mentioned above, in addition to or instead of locally receiving a key, the ultrasound device 100 can remotely receive a key, as illustrated in the flow chart of FIG. 4. First, a user requests a key from a remote source, such as an ultrasound device vendor (step 410). As described in more detail below, the request preferably comprises information identifying the feature to be enabled and the specific ultrasound device. Next, the key is generated by the remote source (step 420) and transmitted to the ultrasound device 100 via the key receiver 150, which can be, for example, a network link or modem (step 430). It is possible that the remote source can generate an incorrect key or that a correctly generated key can become corrupted by a noisy transmission. Accordingly, it is preferred that the feature control manager 130 verify the received key to ensure that it will enable the feature and acknowledge receipt to the remote source (step 440). If an acknowledgement is not received or if an error message is generated, the remote source can retransmit the key (step 450). It is important to note that although the method described above is preferred, other methods can be used. Regardless of the way in which the key is received, it is preferred that the received key be stored in the feature control database 160 for future or repeated use. Alternatively, the received key can be valid only for a single use.

The remote ultrasound vendor 410 transmitting the key to the ultrasound device 100 fails to disclose, *inter alia*, a centralized facility receiving from a user remote from a remote stand-alone ultrasound device an activation request for the option resident in the memory of the remote stand-alone ultrasound device. Simply missing from the Office Action's citation to Fenstemaker is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

So, the Office Action's citation to Fenstemaker fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

The shortcomings of the Office Action's citations to Whigham and Fenstemaker relative to certain elements of the claimed invention have been discussed above. The Office Action proposes a combination of the citations to Whigham and Fenstemaker with a citation to Rive. However, the Office Action's citation to Rive does not overcome the deficiency of the Office Action's citations to Whigham and Fenstemaker. Applicants respectfully submit that the proposed combination of the Office Action's citation to Whigham and Fenstemaker with the

Office Action's citation to Rive fails to provide the required approach, assuming, *arguendo*, that the combination of the Office Action's citations to Whigham and Fenstemaker with the Office Action's citation to Rive is proper.

Rive discloses (column 5, lines 45-62, and column 18, lines 4-53) a computer system 50 and support computer 300 having remote access clients 304 installed thereon that enable the support computer 300 to take control of, or at least access, the computer system 50 for the purposes of modifying the configuration of the supported partition 54:

FIG. 4 is a block diagram illustrating a computer system 50, configured according to an exemplary embodiment of the present invention. Specifically, the computer system 50 is shown to include a storage device, in an exemplary form of a hard drive 52, that is configured to include four partitions, each of which supports an operating environment. While the storage device is shown to be included within the computer system 50, the present invention requires that the storage device merely be accessible by the computer system 50, and could be external to the computer system 50 and, for example, accessed over a network. Alternatively, the storage device may be a hard drive 52 that is directly accessible by the computer system 50.

The hard drive 52 is shown to include four partitions, namely a supported partition 54 from which a supported environment is implemented, an unsupported partition 56 from which an unsupported environment is implemented, a mirror partition 58 and an output partition 60.

...

...The steps illustrated in FIG. 12 will be described with reference to FIG. 13, which is a block diagram illustrating an exemplary embodiment of a remote computer 50 with a supported partition 54 having a specific configuration and a support computer 300 that is capable of remotely accessing the computer system 50 by a network, such as for example the Internet 302. To facilitate this remote access, the computer system 50 and the support computer 300 have remote access clients 304 installed thereon that enable the support computer 300 to take control of, or at least access, the computer system 50 for the purposes of modifying the configuration of the supported partition 54. In one exemplary embodiment, the remote access clients 304 may comprise NetMeeting.TM. client programs, developed by Microsoft Corporation. In an alternative embodiment, the remote access client 304 may comprise the pcAnywhere.TM. software, developed by Symantec Corporation.

Returning to FIG. 13, at step 280, the support computer 300 establishes remote control of, or at least access to, the computer system 50 via a network, for example the Internet 302. In this way, a support technician operating the support computer 300 is, at step 282, able remotely to access a registry editor 46 installed within the supported partition 54.

At step 284, the service technician, via the support computer 300 on the network 302, supplies a unique password to "unlock" the registry editor 46, and to disable the restrictions placed on the registry editor during an initial configuration of the supported partition 54. Having thus supplied the password, the service technician is, at step 286, able remotely to modify the registry 40 to enable launch, operation and execution of a pre-installed, but previously disabled

or inactive, application program installed on the supported partition 54. As mentioned above, this may involve the removal of various restrictions implemented via the registry 40 and via the policy file 41. For example, the selected application may be designated as an “allowed” application, in which case the restrictions implemented by the registry 40 will no longer be applicable. Furthermore, icons via which a user may conveniently launch the relevant application may be restored to appropriate menus presented by the operating system 62 for the supported partition 54.

At step 288, the service technician may then restore restrictions imposed by the registry 40 applicable to the registry 40 itself, and to other applications that are not to be enabled or activated. At step 290, the service technician, via the support computer 300, then terminates the remote control of, or access to, the remote computer 50. The methodology then terminates at step 292.

The service technician via the support computer 300 supplying the unique password to unlock the registry editor 46 and disable the restrictions placed on the registry editor during an initial configuration of the supported partition 54 on the hard drive on the computer system 50 fails to disclose, *inter alia*, a centralized facility receiving from a user remote from a remote stand-alone device an activation request for the option resident in the memory of the remote stand-alone device. Simply missing from the Office Action’s citation to Rive is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants’ independent claim 17. In this regard, the Office Action concedes (page 11, enumerated paragraph 18): “Rive lacks the user being remote from the centralized facility and the remote stand-alone device.”

So, the Office Action’s citation to Rive fails to satisfy at least one of the limitations recited in Applicants’ independent claim 17.

In connection with a number of Applicants’ dependent claims, the Office Action’s citations to Mccown, Castagna, Dutta, Rose, and Takae, assuming, *arguendo*, they are correct, on their face fail to disclose, *inter alia*, the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants’ independent claim 17.

The Office Action's citations to Steinmetz, Whigham, Fenstemaker, Rive, Mccown, Castagna, Dutta, Rose, and Takae all fail to meet at least one of Applicants' claimed features. For example, there is no teaching or suggestion in the Office Action's citations to Steinmetz, Whigham, Fenstemaker, Rive, Mccown, Castagna, Dutta, Rose, and Takae of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

Furthermore, the Office Action does not allege that the art of record provides any teaching, suggestion, or incentive for modifying the citations to Steinmetz, Whigham, Fenstemaker, Rive, Mccown, Castagna, Dutta, Rose, and/or Takae to provide the claimed approach.

In addition, the Office Action includes the following statement (page 12, enumerated paragraph 18):

Regarding claim 3, Rive explicitly lacks renting the option for a trial period of thirty days. However, the examiner takes Official Notice that renting an item for thirty days is old and well established in the art of renting/leasing as a method of allowing a user to access an option for one month. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to rent the option specifically for thirty days. One of ordinary skill in the art would have been motivated to perform such a modification to engage in a monthly subscription. This advantage is well known to those skilled in the art.

To the extent the Official Notice is used to reject Applicants' dependent claim 3, the application of Official Notice is inappropriate under the Manual Patent Examining Procedure (MPEP). "The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." MPEP §2144.03. However, MPEP §2144.03 is clear that "such rejections [relying on official notice] should be judiciously applied," be "rare," and be used "[i]n limited circumstances." Furthermore, "any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection." MPEP §2144.03. To the extent the Official Notice is used to reject Applicants' dependent claim 3, Applicants do not believe that the use of Official Notice is merely to "fill in the gaps." That is, the Official Notice is directed to an entire element

of Applicants' claim 3, thereby effectively attempting to fill in apparent "holes" in the rejection rather than "gaps." The use of the Official Notice to reject Applicants' claim 3 is hereby traversed. The Examiner must "cite a reference in support of his or her position" should the Applicant traverse the assertion. MPEP § 2144.03. The reference cited by the Examiner, Rive, is inadequate for the rejection of Applicants' claim 3.

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03 citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). In the context of rejecting Applicants' claim 3, it is insufficient to allege that renting an item for thirty days is old and well established in the art of renting/leasing as a method of allowing a user to access an option for one month. Rather, the Examiner must establish that such was well known at the time of invention and within the context and use claimed. Applicants believe that at the time of invention, enabling user access to the non-enabled option resident on the device for a trial period of thirty days was not old and well established. In Rive, as noted above, the service technician via the support computer 300 supplying the unique password to unlock the registry editor 46 and disable the restrictions placed on the registry editor during an initial configuration of the supported partition 54 on the hard drive on the computer system 50 fails to disclose, *inter alia*, a centralized facility receiving from a user remote from a remote stand-alone device an activation request for the option resident in the memory of the remote stand-alone device.

"The requirement 'at the time the invention was made' is to avoid impermissible hindsight." MPEP §2141.01. It is believed that the use of the Official Notice to reject Applicants' claim 3 constitutes impermissible hindsight reconstruction.

For the reasons presented above with reference to claim 17, claims 1, 10, 17, and 22 are believed neither anticipated nor obvious over the art of record. The corresponding dependent claims are believed allowable for the same reasons as independent claims 1, 10, 17, and 22, as well as for their own additional characterizations.

Withdrawal of the § 103 rejections is therefore respectfully requested.

Therefore, in light of at least the foregoing, Applicants respectfully believe that the present application is in condition for allowance. As a result, Applicants respectfully request timely issuance of a Notice of Allowance for claims 1-29.

Applicants hereby authorize charging of deposit account no. 50-2402 for any additional fees associated with entering the aforementioned claims.

Applicants appreciate the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

/Robert J. Brill/

Robert J. Brill
Registration No. 36,760
Direct Dial 773-832-4070
rjb@zpspatents.com

Dated: April 6, 2006
Attorney Docket No.: GEMS8081.123

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170